

### **REMARKS**

In the Office Action, claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Claim 8 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1-5, 7 and 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-8 and 10-15 of copending Application No. 10/576,904.

Claims 1-5, 7 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1-6 are herein amended. Claim 8 is herein cancelled without prejudice.

No new matter has been introduced by the amendment.

Claims 1-7 are pending in the case.

Reconsideration of the present application in view of the foregoing amendment and the remarks below is respectfully requested.

### **Information Disclosure Statement**

A part of the Information Disclosure Statement filed March 6, 2006 (the Office Action incorrectly recites the date as "03/10/2005") was not considered because legible copies of the cited references had not been submitted.

Applicants submit herewith a corrected Information Disclosure Statement, including legible copies of the cited reference.



Accordingly, Applicants respectfully request that the listed references be considered.

**Claim Rejections under 35 U.S.C. § 112**

(1) Claim 8 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claim 8 is herein cancelled without prejudice. Applicants expressly reserve a right to pursue the cancelled subjects matter in a continuation application(s).

Accordingly, the rejection of claim 8 is now moot.

(2) Claims 1-5, 7 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claim 8 is herein cancelled and, therefore, the rejection of this claim is now moot.

Specifically, the Office Action states that "the phrase 'W is a six-membered, non benzofused, phenyl' is not clear."

Applicants respectfully traverse the rejection.

Applicants believe the cited phrase is clear in that the terms "six-membered" as well as "non-benzofused" refer to both phenyl and heteroaryl; otherwise, it would not make sense to use the term "six-membered" in connection with phenyl only, as phenyl is "six-membered" by definition. Moreover, the way the commas are placed also supports this interpretation.

Nevertheless, Applicants have herein amended claim 1 for even further clarification in order to avoid any possible misinterpretation.



The Office Action further states that "the phrase 'solvent complexes or morphological forms' is not clear".

The phrase is herein deleted, without prejudice, to solely accelerate the prosecution of the case.

Accordingly, the rejection of claim 1 and its dependent claims 2-5 and 7 should be withdrawn.

### **Claim Rejection on the Ground of Nonstatutory Double Patenting**

Claims 1-5, 7 and 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-8 and 10-15 of copending Application No. 10/576,904.

The rejection of claim 8 is now moot as it is herein cancelled.

Since the present application is a U.S. national stage application of International Application No. PCT/EP2004/004371 filed April 26, 2004, which is earlier than the filing date (October 18, 2004) of PCT/EP04/11704 on which copending Application No. 10/576,904 is based, Applicants believe no terminal disclaimer is necessary to obviate the rejection in the present application.

Accordingly, Applicants respectfully request that the rejection of claims 1-5 and 7 on the ground of nonstatutory obviousness-type double patenting over claims 1, 3-8 and 10-15 of copending Application No. 10/576,904 be withdrawn.

### **Additional Amendment**

Claim 6 is herein amended to delete the designation "(rac.)-" for each compound. Support for the amendment can be found, for example, at page 4, line 29, and at page 8, last paragraph through page 9, first paragraph of the present specification. No new matter has been introduced by the amendment.



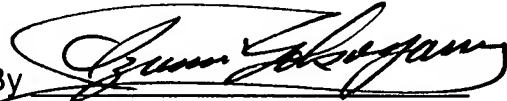
Application No. 10/554,702  
Amendment dated October 25, 2007  
Reply to Office Action of July 25, 2007

Docket No.: A0345.0015

Applicants believe all the pending claims are now in condition for allowance, an early notification of which is respectfully requested.

Dated: October 25, 2007

Respectfully submitted,

By 

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**Copies of Information:**

In accordance with 37 C.F.R. §1.98(a), the following are enclosed:

- ☒ A legible copy<sup>4</sup> of each document (or relevant portion thereof) cited in the attached PTO/SB/08, except for U.S. patent and U.S. published applications.
- ☐ With respect to any information which is not in English, a concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, is attached. This concise explanation is provided by way of:
- ☐ A translation of the relevant portions of the non-English language information<sup>5</sup>;
  - ☐ A statement explaining the relevant portions of the non-English language information;
  - ☐ A copy [and, where not in the English language, a translation] of at least the relevant portion(s)<sup>6</sup> of the communication from a foreign patent office in a counterpart foreign application in which the information was cited; or
  - ☐ This information is contained in the specification of the present application.

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<sup>4</sup> A legible copy of the document is not required if (1) the information was previously cited by, or submitted to, the Office and considered by the Office in a prior U.S. application to which this application claims priority, provided that the prior application is properly identified in this IDS, and (2) the IDS submitted in the earlier application complies with 37 C.F.R. § 1.98(a) – (c). This exception does not apply to information cited in an International Application.

<sup>5</sup> 37 C.F.R. §1.98(a)(3)(ii) *requires* that an English language translation be provided when a translation of the document, or portion thereof, "is within the possession, custody or control of, or is readily available to any individual designated in 37 C.F.R. § 1.56(c)."

<sup>6</sup> The relevant portion is that portion which indicates the degree of relevance found by the foreign patent office. This may be an explanation of which portion of the of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report. MPEP §609 III A(3).



☐ In accordance with 37 C.F.R. 1.98(d), copies of the cited documents are not enclosed as they were provided in application Serial No. \_\_\_\_\_, filed, which the present application relies upon for an earlier effective filing date under 35 U.S.C. 120.

**Materiality:**

Whether or not the information and references disclosed in this Information Disclosure Statement is "material" pursuant to 37 CFR 1.56, this submission is not intended to constitute an admission that any patent, publication or other information referred to therein is "prior art" for this invention unless specifically designated as such.

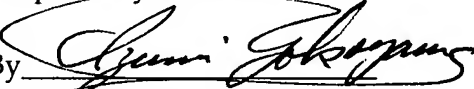
In accordance with 37 CFR 1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 CFR 1.56(a) exists.

It is submitted that the Information Disclosure Statement is in compliance with 37 CFR 1.98 and the Examiner is respectfully requested to consider the listed references.

In the event the actual fee is inadvertently not enclosed or if any additional fee during the prosecution of this application is not paid, the Patent Office is authorized to charge the underpayment to Deposit Account No. 50-2215.

Dated: October 25, 2007

Respectfully submitted,

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